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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/091,394	03/07/2002	Atsushi Yokouchi	Q68888	9620

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2100 PENNSYLVANIA AVE. NW
WASHINGTON, DC 20037-3213

EXAMINER

MCAVOY, ELLEN M

ART UNIT	PAPER NUMBER
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1764

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05/31/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/091,394

Applicant(s)

YOKOUCHI ET AL.

Examiner

Ellen M. McAvoy

Art Unit

1764

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 March 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 18-24 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 18-24 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 18-24 are still rejected under 35 U.S.C. 103(a) as being unpatentable over Yokouchi et al (JP-A-9-169989) in view of Heimann et al (6,010,984).

Applicants' arguments filed 22 March 2007 have been fully considered but they are not persuasive. As previously set forth, Yokouchi et al ["Yokouchi"], which is the priority document of U.S. Patent No. 5,840,666, teach a rolling bearing which may be used in electrical parts and auxiliary engine equipment for automobiles having sealed therein a grease composition comprising a base oil, a urea thickener, and an inorganic filler having an average particle size of not greater than 2 micrometers. See column 3, lines 15-19, of the US patent. The inorganic filler includes metal oxides (e.g., SiO₂, Al₂O₃, MgO, TiO₂ and ZnO), metal nitrides, metal carbides, clay minerals, diamond, and solid lubricants such as MoS₂, graphite, BN, and WS₂. The inorganic filler is preferably used in an amount of 0.05 to 15% by weight. See column 4, lines 21-23. The base oil preferably has a kinetic viscosity of 10 to 400 mm²/sec, particularly 20 to 250 mm²/sec, especially 40 to 150 mm²/sec at 40°C. See column 5, lines 53-60. The grease composition can further contain one or more additives in a total amount of up to 20% by weight as set forth in column 6, lines 35-39. Suitable additives include amine antioxidants and dithiophosphate compounds which act as extreme pressure agents and as antioxidants. While

Yokouchi teaches the addition of further additives, Yokouchi differs from the instant claims in not teaching the addition of a pH adjustor, but the prior art does teach the addition of amine compounds which act as pH adjustors in applicants' claimed invention.

Heimann et al ["Heimann"] teach lubricant and grease compositions which contain base lubricating oils and a thickener including diurea compounds which impart corrosion and microbial resistance, and a high dropping point as set forth in column 2, lines 12-15. The pH of the grease can be tailored to be compatible with the metal surface which is contacted with the grease or gel. See column 5, lines 59-60. The pH adjustor of Heimann is an alkali silicate such as sodium silicate. The grease will typically have a pH that ranges from about 7 to about 14 as set forth in column 6, lines 2-3. The addition of conventional additives is taught in column 8, lines 5+.

The examiner maintains the position that a person having ordinary skill in the art, armed with the disclosure of Heimann, would have found it obvious to add a pH adjustor to the grease composition of Yokouchi in order to adjust the pH to "about 7 to about 14" and tailor the grease to be compatible with the metal surface which is contacted with the grease with a reasonable expectation of enhancing the corrosion resistance of said composition.

Applicants argue that:

"Yokouchi teaches a rolling bearing which is sealed with a grease composition comprising a base oil, a urea thickener, and an inorganic filler having an average particle size of not greater than 2 um (abstract). Yokouchi discloses that the grease composition may further include suitable additives such as amine antioxidants and dithiophosphate compounds (col. 6, lines 35-49). While Yokouchi teaches a grease composition which further includes additives such as amines, Yokouchi does not teach or suggest a grease composition comprising a pH adjustor, as recited in Applicants' claims 18-20. The Examiner acknowledges

this deficiency in Yokouchi on page 3 of the Non-final Office Action dated January 17, 2007.”

This is not deemed to be persuasive because, as set forth by applicant, Yokouchi teaches the addition of amine compounds. A suitable pH adjustor of the claims is an amine compound which is broadly selected from primary to tertiary amine compounds, each hydrocarbon group of which has 1 to 24 carbon atoms. The examiner is of the position that the amine compounds of Yokouchi, although taught as antioxidants, must also have some functionality as pH adjustors. Further, as set forth above, the reference to Heimann teaches that the pH of grease compositions can be tailored to be compatible with the specific metal surfaces with which the greases comes into contact. Accordingly, it would have been obvious to one having ordinary skill in the art to adjust the pH of a grease composition to “about 7 to about 14” and tailor the grease to be compatible with the metal surface with which it is contacted with a reasonable expectation of enhancing the corrosion resistance of said composition.

Applicants also argue

“...as claimed in amended claims 18-20, the pH adjustor is not an alkali silicate, but instead the pH adjustor is selected from an amine compound, an organic acid metal salt and an alkaline inorganic substance, the alkaline inorganic substance being selected from a metal hydroxide, a metal carbonate and a metal borate *to the exclusion of the metal silicate of Heimann*. Thus, although the Examiner uses Heimann to supplement the deficiencies of Yokouchi, it is clear that Heimann does not teach or suggest a pH adjustor as recited in Applicants’ claims 18-20.”

This is not deemed to be persuasive because the pH adjustor may be selected from an amine compound. As set forth above, Yokouchi teaches the addition of an amine compound to the grease compositions.

Claim Rejections - 35 USC § 103

Claims 18-24 are also still rejected under 35 U.S.C. 103(a) as being unpatentable over Naka et al (5,728,659) in view of Heimann et al (6,010,984) and Yokouchi et al (JP-A-9-169989).

Applicants' arguments filed 22 March 2007 have been fully considered but they are not persuasive. As previously set forth, Naka teaches a grease composition for a rolling bearing comprising 10 to 60 parts by weight of a mixture of diurea compounds as a thickener based on 100 parts by weight of a base oil. See column 2, lines 13-44. The base oil used in the grease is not particularly limited, and any oil used as a base oil for a lubricating oil may be used as set forth in column 5, lines 9-11. Base oils having a kinematic viscosity of preferably 40 to 400 mm²/s, more preferably 60 to 250 mm²/s, most preferably 80 to 150 mm²/s at 40°C is preferred. See column 5, lines 11-18. The grease composition may optionally contain publicly known additives in order to further improve its properties as set forth in column 7, lines 31-33. These additives may be used alone or as a combination of two or more kinds. Suitable additives include metal soaps, amine antioxidants and dithiophosphate compounds which act as extreme pressure agents and antioxidants. The amount of the additives to be added is not particularly limited, but usually not more than 20% by weight of the grease composition as set forth in column 7, lines 42-47. Naka differs from the instant claims in not teaching the addition of a pH adjustor and inorganic particles having an average particle size of 2 micrometers or less.

Heimann et al ["Heimann"] and Yokouchi et al ["Yokouchi"] are relied on as outlined above. The examiner maintains the position that it would have been obvious to one having

ordinary skill in the art at the time the invention was made to add a pH adjustor as taught by Heimann to the grease composition of Naka in order to adjust the pH to “about 7 to about 14” and tailor the grease to be compatible with the metal surface which is contacted with the grease with a reasonable expectation of enhancing the corrosion resistance of said composition. Additionally, it would have been obvious to add an inorganic filler as taught by Yokouchi in order to reinforce the gel structure and film-forming properties of the grease composition.

Applicants argue that:

“The Examiner turns to Heimann to supplement the deficiency in Naka and Yokouchi. As discussed above with respect to the previous rejection, Heimann teaches a pH adjustor in which the pH adjustor may be an alkali silicate, such as sodium silicate or calcium silicate (col. 5, lines 63-65), which metal silicate has been excluded from the scope of the claimed pH adjustor. Thus, although the Examiner uses Heimann to supplement the deficiencies of Naka and Yokouchi, it is clear that Heimann does not teach or suggest a pH adjustor as recited in Applicants’ claims 18-20.”

This is not deemed to be persuasive because Naka teaches the addition of known additives such as amine compounds and metal soaps in column 7, lines 31-47. A suitable pH adjustor of the claims is an amine compound which is broadly selected from primary to tertiary amine compounds, each hydrocarbon group of which has 1 to 24 carbon atoms, and an organic acid metal salt. The examiner is of the position that the amine compounds and the metal soaps of Naka must also have some functionality as pH adjustors. Further, as set forth above, the reference to Heimann teaches that the pH of grease compositions can be tailored to be compatible with the specific metal surfaces with which the greases comes into contact. Accordingly, it would have been obvious to one having ordinary skill in the art to adjust the pH of a grease composition to “about 7 to about 14” and tailor the grease to be compatible with the

metal surface with which it is contacted with a reasonable expectation of enhancing the corrosion resistance of said composition.

THIS ACTION IS MADE FINAL. Applicants are reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

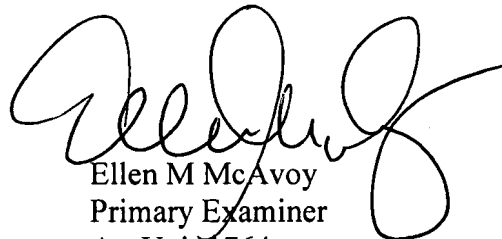
A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ellen M. McAvoy whose telephone number is (571) 272-1451. The examiner can normally be reached on M-F (7:30-5:00) with alt. Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Glenn Caldarola can be reached on (571) 272-1444. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 1764

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Ellen M McAvoy
Primary Examiner
Art Unit 1764

EMcAvoy
May 25, 2007